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| 09/854,617 | 05/14/2001 | Yohnosuke Furui | JP9-2000-0025-JP1 (8728-5) | 9199 |
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| F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797 | | | POLLACK, MELVIN H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2145 | |

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,617

Applicant(s)

FURUI ET AL.

Examiner

Melvin H. Pollack

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. Bienvenu, as shown earlier, details a document provider system in which many of the documents are restricted to subscribers of the particular document. To wit, some subscribers may subscribe to all the publications, and thus receive all the data. Other subscribers may only subscribe to certain publications, and thus receive only a subset of the restricted data corresponding to their Publisher Subscriber Agreement. Still other users on the network, such as open subscribers, are blocked from all the restricted data, and receive only unrestricted data (open publications) and information describing the type of content and how to receive it.
3. To allow business users to actually find relevant information (col. 3, lines 34-60), the system utilizes a search engine (col. 7, lines 20-25) that develops and uses data describing the documents (col. 8, lines 1 – 65). In response to the applicant's allegation that such a system does not open information for publicly-accessible search engine robots (P. 8, lines 18-20), such a system even makes open publication data available to publically accessible search engines, including industry-wide public data (col. 4, line 50 – col. 5, line 10), and may further provide restricted data meant to regard market news or to provide information to potential customers or suppliers (col. 5, lines 20-65, esp. lines 30-45). But even if the applicant's allegation were true, one of ordinary skill in the art would recognize Bienvenu's internal search engine, and the desire to utilize search methods – even public-access search engines – to improve its capabilities and therefore improve a knowledge worker's ability to find relevant information.

Art Unit: 2145

4. The examiner withdraws the claim objections in light of the amendment.

5. Applicant argues that the section mentions only one type of subscriber: that who is under a Publisher Subscriber Agreement (P. 7, lines 14-18), hereinafter referred to as a PSA. The purpose of the PSA is to specify which type of subscriber a particular user is, and more particularly to specify which restricted publications, if any, a user may access. Thus, while all users may be under a PSA, one user's PSA may specify the user has access to all the documents, a second user's PSA may specify that the user has access to only some of the documents, and a third user's PSA may specify that the user has access to none of the documents at all. Further, if there were only one type of subscriber, as the applicant alleges, the PSA would be superfluous.

6. Applicant states that Bienvenu does not expressly disclose the usage of metadata in the particular context (P. 7, lines 19 – P. 8, line 2). While Bienvenu does not expressly use the term in the section pointed, the section shows the relationship of the data to data descriptors. More specifically, a document is associated with data regarding the document, such as its source, type, and published date (col. 8, lines 1-15), and these fulfill the definition of metadata, which will be added to documents that do not originally have them (col. 7, lines 5-35). Thus, Bienvenu teaches the functional equivalent of metadata and its usage, regardless of the terminology used.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (P. 8, lines 3 – 20), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge

Art Unit: 2145

gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bienvenu clearly shows both an internal search engine, as shown above, and information that may be desired by those outside the network, as further shown above. In both cases, it is clear that one of ordinary skill in the art would desire to improve the internal search engine, and to handle outside queries. Further, the purpose of Knauft is to improve public-access search engines for the express purpose of handling business networks with restricted documents, i.e. a Bienvenu network. Therefore, the motivation to combine may not be considered hindsight, for the reasons given prior.

9. The applicant argues that Bienvenu does not expressly disclose transmission source determiners, and usage (P. 8, line 21 – P. 9, line 8). Fig. 1, #30 is used to determine whether an access request occurs, and to collect and sort information to associate information with access levels (col. 5, line 65 – col. 6, line 10). Fig. 1, #32 is used to determine the source of the requestor, and to further determine access rights of the subscriber in light of the PSA specifying the subscriber type of the requestor (col. 6, line 10 – col. 7, line 5). Such system may also handle database search queries (Fig. 1, #35), and this in view of previous search teachings above

Art Unit: 2145

provides a need of the system to handle search robots, such robots being well known in the art at the time of the invention.

10. Applicant finally argues that the structure of metadata is not non-functional descriptive material (P. 9, lines 9-21). The metadata, by itself, is considered by the office to be a mere arrangement of data, as opposed to a data structure as defined in the art. Further, functionality requires a useful, concrete and tangible result. Bienvenu in view of Knauft clearly shows the development of metadata of some form, and the transmission of metadata to a search engine for usage in searching. The types of information contained within the metadata package, as shown, does not constitute a significant change in functionality, nor does it constitute a novel and non-obvious limitation over the cited art.

11. Therefore, the rejection is maintained for the reasons above. This rejection is final.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 17, 20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu et al. (6,526,438) in view of Knauft et al. (6,654,754).

14. For claims 17, 20, 22, Bienvenu teaches a system (abstract) established in a communication network (col. 1, line 1 – col. 4, line 22) comprising:

a. A data manager (col. 5, line 65 – col. 6, line 40), for storing:

Art Unit: 2145

- i. Subscriber information for a first set of paid subscribers (col. 5, lines 55-65);
 - ii. Partial subscriber information for a second set of paid subscribers (col. 5, lines 55-65), and
 - iii. Metadata describing the subscriber information for a non-paying non-subscriber (col. 5, lines 20-30);
- b. A transmission source determiner (Fig. 1, #30), for receiving an access request to the data manager from a transmission source (col. 10, lines 55-65), and for determining whether the transmission source is one of the first set of subscribers, the second set of subscribers, or the non-subscriber (Fig. 1, #32); and
- c. A response unit (Fig. 1, #36), for
- i. If the transmission source determiner determines that the transmission source is the first set of paid subscribers, transmitting said subscriber information to the transmission source through the communication network (Fig. 1, #26),
 - ii. If the transmission source determiner determines that the transmission source is the second set of paid subscribers, transmitting said partial subscriber information to the transmission source through the communication network (Fig. 1, #31), and
 - iii. If the transmission source determiner determines that the user is one of the non-paying non-subscriber, transmitting said metadata to the transmission source through the communication network (Fig. 1, #16);

Art Unit: 2145

- d. Wherein the first set of paid subscribers has full unrestricted access to an information site (col. 10, lines 15-40: full access subscribe to all publications and gain broader access rights);
 - e. Wherein the second set of paid subscribers has partially restricted access to the information site (col. 10, lines 15-40: partial access includes at least one but not all publications and/or some but not all access rights);
 - f. Wherein the non-paying non-subscriber has no access to the information site (col. 4, lines 60-62; col. 6, lines 20-25).
15. Bienvenu does not expressly disclose that metadata comprises a textual description of the subscriber information, a keyword related to the textual description for preparing a search engine keyword index, and subscription information describing how to obtain access to the subscriber information and the partial subscriber information.
16. However these differences are only found in the non-functional data stored on the article of manufacture. Data of the above types are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
17. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture as shown in Bienvenu because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been

Art Unit: 2145

obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

18. Bienvenu does not expressly disclose information regarding search engine robots. Knauft teaches a system (abstract) of providing information to search engines regarding restricted documentation (col. 1, line 1 – col. 3, line 15) comprising:

- a. A data manager (Fig. 1, #110) for storing metadata describing the subscriber information for a search engine robot (Fig. 2, #216);
- b. A transmission source determiner for determining whether the transmission source is the search engine robot (col. 5, line 65 – col. 6, line 30; col. 5, line 65 – col. 7, line 15);
- c. A response unit for if the transmission source determiner determines that the user is the search engine robot, transmitting said metadata to the transmission source through the communication network (col. 5, line 65 – col. 7, line 15);
- d. Wherein metadata comprises textual description and keywords related to the textual description for preparing a search engine keyword index (col. 6, lines 30-65).

19. At the time the invention was made, one of ordinary skill in the art would have added Knauft to Bienvenu in order to allow restricted data to be indexed (col. 2, lines 30-40), Knauft having been designed to work with restricted document systems (col. 1, line 55 – col. 2, line 5).

20. Claims 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu and Knauft as applied to claim 17 above, and further in view of Wyngarden (6,694,365).

Art Unit: 2145

21. For claim 18, Bienvenu and Knauff do not expressly disclose the details of their authentication mechanism. Wyngarden teaches a system (abstract) of providing restricted information to a user (col. 1, line 1 – col. 3, line 30) in which an information communication terminal, for accessing the information site on the communication network (Fig. 1), and for obtaining information available at said information site (Fig. 2; col. 4, lines 5-20); wherein a request for said information and identification information for said information communication terminal is transmitted to acquire said information (col. 4, lines 11-13); wherein when said information falls in an access right range that is set in accordance with said identification information, said information is provided by said information site; and wherein when said information does not fall in said access right range, metadata for describing said information is provided (col. 5, lines 25-35). At the time the invention was made, one of ordinary skill in the art would have added Wyngarden authentication processes in order to determine details of an essential feature and further in order to preserve segregated areas to maintain user access separation (col. 3, lines 15-30).

22. For claim 19, Bienvenu teaches that said metadata obtained from said information site includes text data for explaining said information (col. 8, line 65 – col. 9, line 15).

23. For claim 21, Bienvenu teaches that each access right of a user for said main information is registered in the user register (Fig. 3, #100), but does not expressly disclose that wherein when a user ID and said access request are received and registered in said user register, said transmission source determiner notifies said response unit of a range of said access rights of said user indicated in said user register; and wherein said response unit generates a metadata response comprising text data for describing said main information, in accordance with said range.

Art Unit: 2145

Wyangarden teaches these limitations, as shown in the claim 18 discussion. At the time the invention was made, one of ordinary skill in the art would have added Wyngarden authentication processes in order to determine details of an essential feature and further in order to preserve segregated areas to maintain user access separation (col. 3, lines 15-30).

24. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu and Knauft as applied to claim 22 above, and further in view of Weil et al. (6,907,423).

Claims 23-25 are drawn to the limitations in claim 22, but add that some search engines may be registered so as to gain more information. Bienvenu and Knauft do not expressly disclose the added limitation. Weil teaches a method (abstract) of obtaining search information from restricted content sites (col. 1, line 1 – col. 3, line 55) in which the search engines are registered (col. 8, lines 15-40) for the purpose of controlling information received by the engine (col. 5, lines 10-55). At the time the invention was made, one of ordinary skill in the art would have added Weil to Bienvenu and Knauft in order to allow selective access to content via search engine (col. 2, lines 35-45). Therefore, since claim 22 is rejected, claims 23-25 are also rejected for the reasons above.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2145

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
24 February 2006


JASON CARDONE
SUPERVISORY PATENT EXAMINER